

REMARKS

I. Information Disclosure Statement

The Applicant calls to the Examiner's attention the reference cited in the Information Disclosure Statement filed contemporaneously with this Reply.

II. 35 U.S.C. § 103(a) Rejections

Independent claims 7, 11 and 16 stand rejected under 35 U.S.C. § 103(a). In particular, independent claims 7 and 16 were rejected over U.S. Pat. No. 6,643,528, issued to Shim et al. ("Shim"), in view of U.S. Pat. No. 6,115,620, issued to Colonna et al. ("Colonna") and further in view of U.S. Pat. No. 6,676,534, issued to Bach et al. ("Bach"), and independent claim 11 was rejected over Shim in view of Colonna and further in view of U.S. Pat. No. 6,018,671, issued to Breamer ("Breamer"). These rejections are traversed.

A. Independent Claims 7, 11 and 16

The rejections of independent claims 7, 11 and 16 are traversed on the grounds that Shim and Colonna are improperly combined because Shim and Colonna teach away from their combination.

Shim explicitly teaches that when a mobile device is received into a holster, the built-in speaker and/or built-in microphone are disabled to avoid processing multiple sets of voice signals:

Optionally, when the radiotelephone 12 is received into the holster 21, the terminal 41-i, or when the audio appliance is extracted for use and the radiotelephone is kept in the holster, and the corresponding terminal 43-i (i=1, 2, 3) make electrical and/or mechanical contact, the built-in speaker and/or built-in microphone (not shown) for the radiotelephone are disabled, to avoid providing

two sets of (possibly confusing) voice signals for the radiotelephone to process, and is optionally re-enabled when the radiotelephone is removed from the holster.

Shim, col. 4, ll. 7-16 (emphasis added). Colonna, on the other hand, explicitly teaches that when a mobile device is received into a holster, the built-in speaker and/or built-in microphone are enabled:

When the EM field is detected, the EM sensor 116 sends an override signal to the controller 106, and the controller 106 will operate the radiotelephone 100 in the speakerphone mode when the controller 106 detects the override signal and the activation signal. For example, a user can place the radiotelephone 100 into a phone receptacle mounted within the interior of an automobile. The phone receptacle comprises a magnet that will emit an EM field of a predetermined strength. When the radiotelephone 100 is placed within, or attached to, the phone holder, the EM sensor 116 produces the override signal. The controller 106 then operates the radiotelephone 100 in the speakerphone mode when the controller has sensed the activation signal and the radiotelephone 100 is in either the speakerphone configuration or the private-mode configuration.

Colonna, col. 3, ll. 34-49 (emphasis added). See also Colonna, col. 4, ll. 50-65; col. 6, ll. 12-34.

Thus, Shim teaches that when the mobile device is in a holster the speakerphone function is disabled to facilitate the further processing as disclosed in Shim, and Colonna teaches that when the mobile device is in a holster the speakerphone function is enabled to facilitate the further processing as disclosed in Colonna. In other words, Shim and Colonna teach processing configurations that are mutually exclusive. Therefore Shim and Colonna clearly teach away from their combination. "It is improper to combine references when the references teach away from their combination." In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

For this reason, the rejection of independent claims 7, 11, and 16, and all claims depending therefrom, is improper and should be withdrawn.

The Applicant notes that Shim is incorrectly cited in the Final Office Action as teaching that the speaker phone is automatically disabled when it is removed from the holster. Final Office Action, pg. 3, ll. 8-12; pg. 6, ll. 14-17. This is contrary to the explicit teaching of Shim cited above. It appears that the combination of Shim and Colonna in the Final Office Action is also based on this incorrect reading of Shim, which further supports the Applicant's position that Shim and Colonna are improperly combined.

B. Independent Claims 7 and 16

The rejections of independent claims 7 and 16 are also traversed on the grounds that Shim, Colonna and Bach do not teach all of the claimed limitations. At the very least, Shim, Colonna and Bach do not teach "delaying notification of the received data message until the dual-mode mobile communication device is able to decrypt and/or decompress the data message, and once the data message has been decrypted and/or decompressed, then notifying a user of the received data message" as claimed in claim 7 or "delaying notification of the received data message until the mobile communication device is able to decrypt and/or decompress the data messages, and once the data message has been decrypted and/or decompressed, then notifying a user of the received data message" as claimed in claim 16.

The Final Office Action alleges that the following passage of Colonna teaches this element of claims 7 and 16:

The radiotelephone 100 detects RF signals containing receive data through the antenna 102 and produces detected RF signals. A receiver within the transceiver 104, coupled to the antenna 102, converts the detected RF signals into electrical baseband signals, demodulates the electrical baseband signals, recovers the receive data, including automatic frequency control information, and outputs the receive data to the controller 106. The controller 106 formats the data into recognizable voice or data information for use by user interface 110. The user interface 110 communicates the received information or voice to a user.

Typically, the user interface 110 includes a microphone, a speaker, a display, a keypad, and special function input elements. The user interface 110 also comprises an activation element, responsive to a user input, for producing an activation signal.

Colonna, Col. 3, ll. 22. This passage from Colonna, however, is merely describing the standard transceiver functions of demodulation and recovery of received data, and does not teach the delaying of a notification until a decryption or decompression of data is complete. In fact, nothing in this passage would preclude Colonna from notifying the user of a received signal wherein the user would have to wait until the data is decrypted or decompressed.

Should the Examiner maintain the rejection, the Applicant respectfully requests that the Examiner specifically cite to the exact language of Colonna that teaches the claimed limitations of claims 7 and 16.

For this additional reason, the rejection of independent claims 7 and 16, and all claims depending therefrom, is improper and should be withdrawn.

III. Conclusion

The Applicant respectfully requests the withdrawal of the rejections in light of the aforementioned arguments. It is believed that the application, as now presented, is in condition for allowance and that a Notice of Allowability be issued is due course.

Respectfully submitted,

JONES DAY

A handwritten signature in black ink, appearing to read 'Paul E. Franz', is written over a horizontal line.

Paul E. Franz
(Reg. No. 45,910)

Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7506